

REMARKS**INTRODUCTION:**

In accordance with the foregoing, the claims have been retained in their present form. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-11, 14, 15 and 17 are pending and under consideration. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

the remarks below explain why the claims should be allowed in their present form and put the application at least into a better form for appeal.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §103:

A. In the Office Action, at pages 2-5, claims 1-6, 11, 14, 15, and 17 (claims 12, 13 and 16 have been canceled) were rejected under 35 U.S.C. §103(a) as being unpatentable over Moudry et al. (US Patent Publication 2005/0160938; hereafter, Moudry) in view of Brechlin et al. (USPN 4,157974; hereafter, Brechlin). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The statute 35 U.S.C. §103(c) (1) states, "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

U.S. Patent Publication US 2005/0160938 by Moudry et al., was assigned to Samsung Electronics Co., Ltd., has a U.S. Patent and Trademark Office filing date of March 22, 2005, and

has priority based on provisional application no. 60/347,184 which was filed on January 8, 2002 and provisional application no. 60/60/346,946 which was filed on January 8, 2002. Moudry et al. was published on July 28, 2005. The present application is also assigned to Samsung Electronics Co., Ltd and has a U.S. Patent Application filing date of February 5, 2004. Therefore, Moudry et al. qualifies as prior art under 35 U.S.C. §102(e).

Applicants respectfully submit that Moudry et al. and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

It is respectfully submitted that applications and patents will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if:

- (a) the applicant provides evidence that the application and patent files refer to assignments recorded in the PTO in accordance with 37 CFR 3.11 which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention;
- (b) copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention are filed in each of the applications and patents;
- (c) an affidavit or declaration by the common owner is filed which states that there was common ownership at the time the invention was made and explains why the affiant believes there was common ownership; or
- (d) other evidence is submitted which establishes common ownership of the applications and patents at the time the invention was made, e.g., a court decision determining the owner.

Hence, it is respectfully submitted that in the present instance, the applicant provides evidence that the application and patent files refer to assignments recorded in the PTO in accordance with 37CFR 3.11 which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention. The assignment information recorded at the U.S. Patent Office for Moudry et al. and the present application are set forth below.

Patent Assignment Abstract of Title

NOTE:Results display only for issued patents and published applications. For pending or abandoned applications please consult USPTO staff.

Total Assignments: 1

Patent #: NONE **Issue Dt:** **Application #:** 1108899
8 **Filing Dt:** 03/22/2005

Publication #: 2005016093 **Pub Dt:** 07/28/2005
8

Inventors: Ronald J. Moudry, James A. Baker

Title: Liquid inks comprising stabilizing organosols

Assignment: 1

Reel/Frame: 016526/0260 **Recorded:** 03/23/2005 **Pages:** 4

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: MOUDRY, RONALD J. **Exec Dt:** 03/23/2005

BAKER, JAMES A. **Exec Dt:** 03/23/2005

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Patent Assignment Details

NOTE:Results display only for issued patents and published applications. For pending or abandoned applications please consult USPTO staff.

Reel/Frame: 014967/0311

Pages: 2

Recorded: 02/05/2004

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Total properties: 1

Patent #: NONE **Issue Dt:** **Application #:** 1077141
0 **Filing Dt:** 02/05/2004

1 Publication #: US2004022503 **Pub Dt:** 11/11/2004
0

Title: Liquid ink composition and preparation of the same

Assignors

1 YON, KYUNG-YOL **Exec Dt:** 02/04/2004

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It is respectfully submitted that at the time of the invention, the present invention was subject to an obligation of assignment to Samsung Electronics Co., Ltd. In addition, Moudry et al. was subject to an obligation of assignment to Samsung Electronics Co., Ltd. at the time of the present invention.

Because Moudry et al. is not prior art under 35 U.S.C. §103(c), withdrawal of this rejection is respectfully requested.

B. In the Office Action, at pages 6-8, claims 1-6, 11, 14, 15, and 17 (claims 12, 13 and 16 have been canceled) were rejected under 35 U.S.C. §103(a) as being unpatentable over Moudry et al. (US Patent Publication 2005/0160938; hereafter, Moudry) in view of Ohsawa et al. (USPN 46,679,597; hereafter, Ohsawa). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

For the reasons cited in "A" above, since Moudry et al. is not prior art under 35 U.S.C. §103(c), withdrawal of this rejection is respectfully requested.

C. In the Office Action, at pages 8-11, claims 1, 4-11 (claim 12 has been canceled) and 15 and 17 (claim 16 has been canceled) were rejected under 35 U.S.C. §103(a) as being unpatentable over Brechlin et al. (USPN 4,157,974; hereafter, Brechlin) in view of Moudry et al. (US Patent Publication 2005/0160938; hereafter, Moudry). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

For the reasons cited in "A" above, it is respectfully submitted that Moudry et al. is not prior art under 35 U.S.C. §103(c), withdrawal of this rejection is respectfully requested.

D. In the Office Action, at pages 11-14, claims 1, 4-11 (claim 12 has been canceled) and 15 and 17 (claim 16 has been canceled) were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohsawa et al. (USPN 46,679,597; hereafter, Ohsawa) in view of Moudry et al. (US Patent Publication 2005/0160938; hereafter, Moudry). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

For the reasons cited in "A" above, since Moudry et al. is not prior art under 35 U.S.C. §103(c), withdrawal of this rejection is respectfully requested.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: July 2, 2007

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